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CHARLES ELMO

IN THE

Supreme Court of the United States

OCTOBER TERM, 1942

No. 509

Can this be folded some way?

GEORGE VAN WORMER,
Petitioner,

vs.

THE CHAMPION PAPER & FIBRE COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS, SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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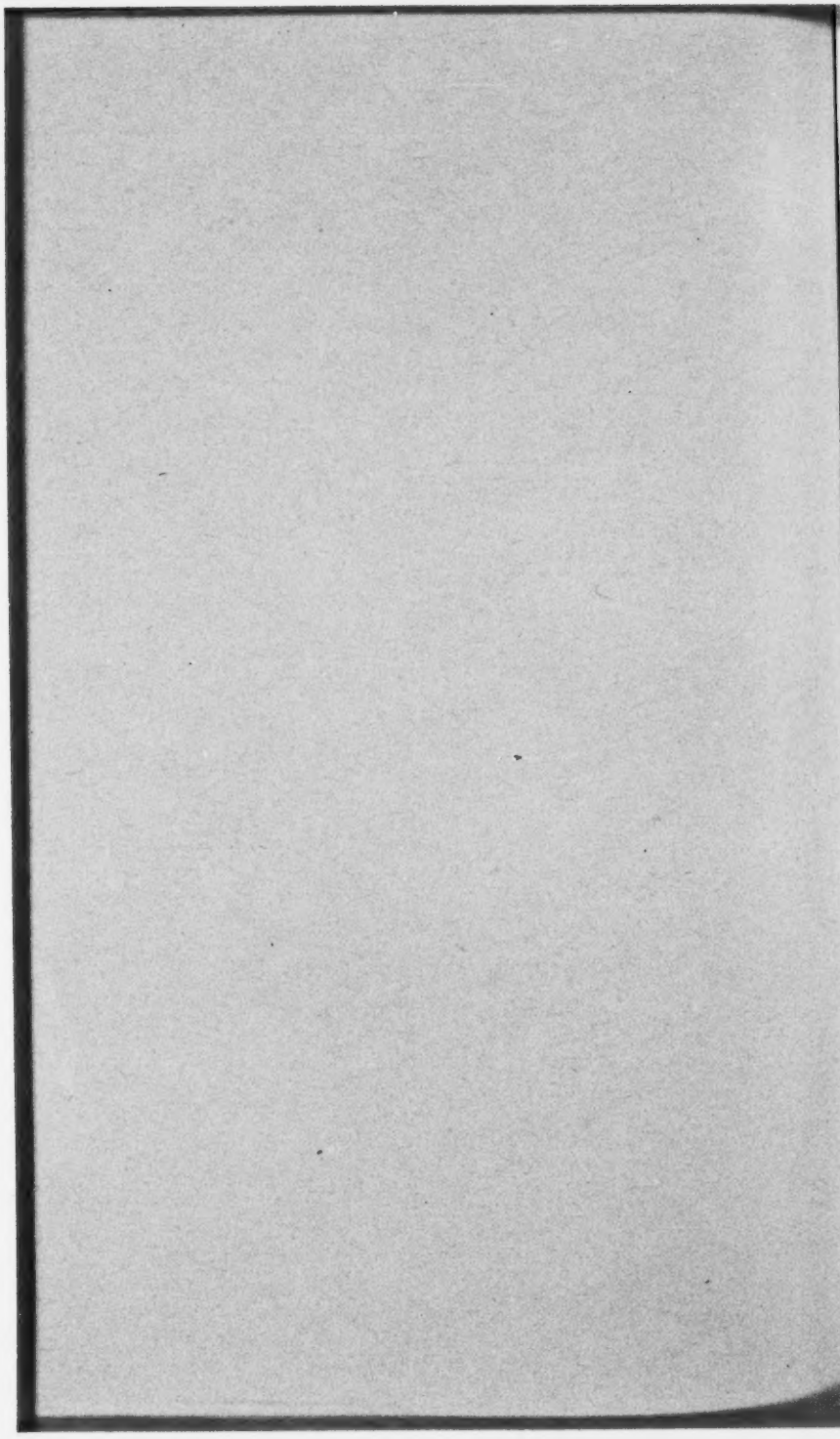

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To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, George Van Wormer, respectfully prays for a writ of certiorari to review a decision and decree of the United States Circuit Court of Appeals for the Sixth Circuit in the above cause, rendered and entered on June 29, 1942, and therefore shows as follows:

SUMMARY STATEMENT OF THE MATTER INVOLVED

Petitioner sued the respondent for infringement of his Patent No. 1,947,748, hereafter referred to as the Van Wormer patent. This patent was for a machine for cleaning the surface of fine paper stock of fibers that had been indented into the paper, and would form white spots in prints by becoming interposed between the paper and the printing press.

The Van Wormer patent described the means for removing the fibers from the paper, as a series of hog-bristle brushes rotated in the direction in which the paper moved through the casing. Claim 1 before the disclaimer, had as an element the following: "paper brushing devices therein arranged and including exceedingly attenuated and flexible paper surface engaging members to engage a moving sheet in the casing".

A need for a disclaimer was made by respondent's setting up the Wood patent in its amendment to its answer. (Rec. page 13). This Wood Patent No. 1,089,453, (Rec. II, page 116), illustrated and described a device that cleaned paper by a pair of rotating brushes made of camel's hair, and rotated in a direction opposite to the movement of the paper.

On September 26, 1938, your petitioner filed the following disclaimer:

> "Hereby enters this disclaimer to the part of claim 1 and claim 2 that relates to the paper brushing devices arranged to engage a moving sheet, except where the brushes are made of a fairly heavy hog bristle and are arranged to rotate in the direction in which the sheet is moving; and that part of claim 3 that relates to rotary brushes except where they are made of a fairly heavy hog bristle."

The District Court found that the disclaimer was invalid. The Court of Appeals of the Sixth Circuit affirmed this finding, saying:

> "We think that appellee's contention that the disclaimer introduced a new element into the claim and hence invalidates it must be sustained. The limitation in the disclaimer to the use of a brush composed of hog bristles does not extend the claim. It originally specified paper brushing devices, and such devices might be either of camel's hair or bristles, or any proper brush material. However, the claim as originally written does not include the rotation of the brushes. It is quite conceivable that under the broad phrase 'paper brushing devices therein arranged' the brushes might be vibrated instead of rotated. Appellee urges, and it is true, that the specifications described rotation of the brushes, but that does not save the claim which is so broadly drawn as not to include this element." Citing *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477 and *Milcor Steel Company* v. *George A. Fuller Co.*, 62 Sup. Ct. 969, 86 Law Ed. 897.

The decision of the Circuit Court of Appeals is reported at 129 Fed. Rep. 2(d) page 428. Petitioner in due time presented to the Circuit Court of Appeals his petition and brief for a rehearing, in which it was stated that; "The Court erred in finding that by the disclaimer the patentee introduced a new element into the claim." (Rec. page 281). The Circuit Court of Appeals denied the Petition for Rehearing on August 28, 1942. (Rec. page 285).

REASONS RELIED UPON FOR GRANTING CERTIORARI

Petitioner is advised, and therefore alleges, that the Decree of the Circuit Court of Appeals in this case shows that there is urgent need for this Court's clarifying what constitutes the addition of a new element to a combina-

tion claim in a patent, in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, and *Milcor Steel Company* v. *George A. Fuller Co.*, 314 U. S. 604.

In the instant case the Court of Appeals, after discussing the Altoona Publix Theatres, Inc. case and the Milcor Steel Company v. George A. Fuller case, said: "This holding compels the conclusion that the addition of the element of rotation of the brushes in the same direction of travel as the paper passing through the machine, which appellant insists is an essential part of the invention, introduces an element not present in the original claim, and thus invalidates both the disclaimer and the claim itself." (Rec. page 278).